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## PATENT APPLICATION

### IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: A7483

Xiao-Mai ZHOU

Appln. No.: 09/580,523

(U.S. Patent 7,193,044, issued March 20, 2007)

Group Art Unit: 1642

Confirmation No.: 8284

Examiner: Minh Tam Davis

Filed: May 30, 2000

For: COMPOUNDS AND METHODS FOR REGULATING APOPTOSIS, AND METHODS OF MAKING AND SCREENING FOR COMPOUNDS THAT REGULATE APOPTOSIS

#### APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705

**MAIL STOP PATENT EXT.**  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

05/09/2007 MAHMED2 00000076 194880 7193044  
01 FC:1455 200.00 DA

Sir:

Applicant requests reconsideration of the Commissioner's determination of patent term adjustment (PTA) as indicated on the Patent that issued March 20, 2007. In particular, Applicant requests restoration of 120 days of PTA erroneously charged against Applicant under 37 C.F.R. § 1.704(c)(10).

This Application is filed less than two months after the issue date of the patent and is therefore timely. (37 C.F.R. § 1.705(d)) The Office is directed and authorized to charge Deposit Account No. 19-4880 for the required fee as specified in §1.18(e) (\$200.00).

05/08/2007 YPOLITE1 00000003 7193044  
Adjustment date: 05/09/2007 MAHMED2  
01 05/08/2007 YPOLITE1 00000003 194880 7193044  
01 FC:1463 200.00 CR

**Facts**

1. Attached is a printout of the Office's determination of PTA for this patent, as provided on PAIR. The net PTA shown on the printout is 1104 days.
2. (§ 1.705)(b)(2)(i)). For the following reasons, the correct PTA to which this patent is entitled is 1224 days.
  3. (§ 1.705)(b)(2)(ii)). The examination delays under § 1.702(a) and § 1.703, are the following:
    - (a) 30 days for failing to mail the Restriction Requirement within 14 months of filing, for the interval between May 30, 2000 and August 29, 2001 (correctly shown on the PAIR printout).
    - (b) 11 days for the interval between March 9, 2007 and March 20, 2007 for delay in issue that is more than four months from the date the Issue Fee was paid (correctly shown on the PAIR printout).
    - (c) 1096 days for the difference between the interval from filing on May 30, 2003 to issue on March 20, 2007 (1390 days) minus the interval from filing an RCE on June 29, 2006 to issue on March 20, 2007 (264 days) minus the 30 day overlap with (a) above.

The sum of these delays is 1137 days (§ 1.703(f)) (correctly shown in the PAIR printout).

4. (§ 1.705)(2)(iii). This application is not subject to a terminal disclaimer.

5. This application was accorded a USPTO Adjustment of 667 days, in response to the Application for Patent Term Adjustment filed November 7, 2006 (368 days to compensate for incorrect calculation of Applicant's delay plus 314 days of PTO actual delay minus 15 days of Applicant's actual delay) (correctly shown in the PAIR printout)

6. (§ 1.705)(2)(iv)(A). Reductions to Patent Term

(a) The reductions under § 1.704 as shown on the attached PAIR printout which Applicant believes to be correct are the following:

(i) 2 days for failing to file a Response to a Non-Final Office Action within three months, for the interval between December 19, 2001 and March 21, 2002.

(ii) 29 days for failing to file a Response to a Final Office Action within three months, for the interval between June 19, 2002 and October 18, 2002.

(iii) 31 days for failing to file a Response to a Non-Final Office Action within three months, for the interval between July 12, 2004 and November 12, 2004.

(iv) 58 days for failing to file a Response to a Non-Final Office Action within three months, for the interval between February 10, 2005 and July 7, 2005.

(v) 92 days for failing to file a Response to a Final Office Action within three months, for the interval between December 29, 2005 and June 29, 2006.

- (b) In addition, the 368 day incorrect entry for a Response after Non-Final Action on April 19, 2004 was compensated for in the Adjustment of PTA Calculation by PTO and, thus, is added to Applicant's delay
- (c). The PAIR entry of 120 days for a Miscellaneous Incoming Letter filed September 20, 2006 does not correspond to a failure by Applicant to engage in reasonable efforts to engage in prosecution.

The sum of Applicant's delay and the incorrect entry of 368 days in 6(b) above is **580** days ( $2+29+31+58+92+368 = 580$ ).

### Discussion

The Miscellaneous Incoming Letter filed September 20, 2006 is an electronically filed Request for Recordation of Assignment, inadvertently filed in the file wrapper. The Request for Recordation of Assignment appears to have been mistakenly interpreted as a Submission under 37 C.F.R. § 1.704(c)(10), which requires a response by the Examiner. However, no response on the part of the Examiner was called for. The Examiner just needed to ignore the paper, as he did. Nonetheless, the paper seems to have been treated as a separate paper for PALM to flag.

Because the paper did not require any action on the part of the Examiner, it did not constitute any new action corresponding to a failure to engage in reasonable efforts to conclude prosecution. Thus the paper should not have been treated as a new filing that was part of the prosecution of the application.

APPLICATION FOR PATENT TERM ADJUSTMENT  
U.S. Appln. No.: 09/580,523 (USP 7,193,044)

Atty. Docket No.: A7483

**Conclusion**

Applicant respectfully requests correction of the Office's records and adjustment of the Office's calculation of term adjustment by adding 120 days of patent term adjustment, making the total adjustment **1224** days (667 days of USPTO adjustment + 1137 days of Office delay - 580 days of Applicant delay).

Respectfully submitted,



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WASHINGTON OFFICE

**23373**

CUSTOMER NUMBER

Date: May 7, 2007

09/580,523	COMPOUNDS AND METHODS FOR REGULATING APOPTOSIS, AND METHODS OF MAKING AND SCREENING FOR COMPOUNDS THAT REGULATE APOPTOSIS	05-04- 2007::15:34:49
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## Patent Term Adjustments

Patent Term Adjustment (PTA) for Application Number: 09/580,523

Filing or 371(c) Date:	05-30-2000	USPTO Delay (PTO) Delay (days):	1137
Issue Date of Patent:	03-20-2007	Three Years:	-
Pre-Issue Petitions (days):	+0	Applicant Delay (APPL) Delay (days):	700
Post-Issue Petitions (days):	+0	Total PTA (days):	1104
USPTO Adjustment(days):	667	Explanation Of Calculations	

## Patent Term Adjustment History

Date	Contents Description	PTO(Days)	APPL(Days)
02-28-2007	PTA 36 Months	1096	
03-20-2007	Patent Issue Date Used in PTA Calculation	11	
02-22-2007	Dispatch to FDC	↑	
02-22-2007	Application Is Considered Ready for Issue	↑	
11-09-2006	Issue Fee Payment Verified	↑	
02-16-2007	Record a Petition Decision of Granted for Patent Term Adjustment after Allowance		
02-16-2007	Record a Petition Decision of Granted for Patent Term Adjustment after Allowance		
02-15-2007	Adjustment of PTA Calculation by PTO		
02-15-2007	Adjustment of PTA Calculation by PTO	368	
02-15-2007	Adjustment of PTA Calculation by PTO	↑	
02-15-2007	Adjustment of PTA Calculation by PTO		15
02-15-2007	Adjustment of PTA Calculation by PTO	↑	
02-15-2007	Adjustment of PTA Calculation by PTO		
02-15-2007	Adjustment of PTA Calculation by PTO	314	
11-09-2006	Petition Entered	↑	
11-09-2006	Issue Fee Payment Received	↑	
09-20-2006	Miscellaneous Incoming Letter		120
09-11-2006	Response to Reasons for Allowance	↑	
08-31-2006	Receipt into Pubs	↑	
08-25-2006	Receipt into Pubs	↑	
08-23-2006	Sequence Forwarded to Pubs on Tape	↑	
08-11-2006	Mail Notice of Allowance	↑	
08-11-2006	Mail Examiner's Amendment	↑	
07-24-2006	Notice of Allowance Data Verification Completed	↑	
07-24-2006	Examiner's Amendment Communication	↑	
07-08-2006	Date Forwarded to Examiner	↑	
07-08-2006	Date Forwarded to Examiner	↑	
06-29-2006	Request for Continued Examination (RCE)		92
07-08-2006	DISPOSAL FOR A RCE/CPA/129 (express abandonment if CPA)	↑	
06-29-2006	Request for Extension of Time - Granted	↑	
06-29-2006	Workflow - Request for RCE - Begin	↑	

06-02-2006	Date Forwarded to Examiner	↑
05-26-2006	Amendment after Final Rejection	↑
05-26-2006	Request for Extension of Time - Granted	↑
05-26-2006	Miscellaneous Incoming Letter	↑
05-15-2006	Mail Examiner Interview Summary (PTOL - 413)	↑
04-27-2006	Examiner Interview Summary Record (PTOL - 413)	↑
12-29-2005	Mail Final Rejection (PTOL - 326)	↑
12-23-2005	Final Rejection	
11-30-2005	IFW TSS Processing by Tech Center Complete	
11-30-2005	Date Forwarded to Examiner	
11-22-2005	Response after Non-Final Action	
08-25-2005	Mail Non-Final Rejection	
08-22-2005	Non-Final Rejection	
07-15-2005	Date Forwarded to Examiner	
07-07-2005	Response after Non-Final Action	58
07-07-2005	Request for Extension of Time - Granted	↑
05-03-2005	Information Disclosure Statement (IDS) Filed	↑
02-10-2005	Mail Non-Final Rejection	↑
02-07-2005	Non-Final Rejection	
11-27-2004	Date Forwarded to Examiner	
11-12-2004	Response after Non-Final Action	31
11-12-2004	Request for Extension of Time - Granted	↑
11-12-2004	Workflow incoming amendment IFW	↑
07-12-2004	Mail Non-Final Rejection	↑
07-09-2004	Non-Final Rejection	
05-12-2004	Date Forwarded to Examiner	
04-19-2004	Response after Non-Final Action	368
04-29-2004	Request for Extension of Time - Granted	↑
05-30-2003	Information Disclosure Statement (IDS) Filed	↑
04-24-2003	Mail Notice of Informal or Non-Responsive Amendment	↑
04-24-2003	Date Forwarded to Examiner	↑
04-17-2003	Informal or Non-Responsive Amendment after Examiner Action	↑
04-17-2003	Response after Non-Final Action	↑
01-17-2003	Mail Non-Final Rejection	
01-13-2003	Non-Final Rejection	
12-19-2002	Notice of Appeal Filed	
12-19-2002	Request for Extension of Time - Granted	
10-24-2002	Date Forwarded to Examiner	
10-18-2002	Amendment after Final Rejection	29
10-18-2002	Request for Extension of Time - Granted	↑
06-19-2002	Mail Final Rejection (PTOL - 326)	↑

06-17-2002	Final Rejection	
04-17-2002	Date Forwarded to Examiner	
03-21-2002	Response after Non-Final Action	2
03-21-2002	Request for Extension of Time - Granted	↑
12-19-2001	Mail Non-Final Rejection	↑
12-17-2001	Non-Final Rejection	↑
10-04-2001	Date Forwarded to Examiner	
09-26-2001	Response to Election / Restriction Filed	
08-29-2001	Mail Restriction Requirement	30
08-27-2001	Requirement for Restriction / Election	↑
02-13-2001	Case Docketed to Examiner in GAU	↑
02-01-2001	Applicant Has Filed a Verified Statement of Small Entity Status in Compliance with 37 CFR 1.27	↑
10-17-2000	Information Disclosure Statement (IDS) Filed	↑
09-12-2000	Case Docketed to Examiner in GAU	↑
08-31-2000	CRF Is Good Technically / Entered into Database	↑
08-17-2000	Application Dispatched from OIPE	↑
08-17-2000	Application Is Now Complete	↑
07-31-2000	Notice Mailed--Application Incomplete--Filing Date Assigned	↑
07-31-2000	Correspondence Address Change	↑
06-20-2000	IFW Scan & PACR Auto Security Review	↑
05-30-2000	CRF Is Good Technically / Entered into Database	↑
05-30-2000	Initial Exam Team nn	↑

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